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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/392,676	09/08/1999	JOSEPH B. SAINTON	0357-20	1605

22204 7590 12/06/2001

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EXAMINER

URBAN, EDWARD F

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 12/06/2001

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/392,676**

Applicant(s)  
**Sainton et al.**

Examiner  
**Edward F. Urban**

Art Unit  
**2683**



**- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -**

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Sep 6, 2001

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-46 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☒ Claim(s) 1-24 and 29-32 is/are allowed.

6) ☒ Claim(s) 25-28 and 33-46 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☒ Interview Summary (PTO-413) Paper No(s). 15

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

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### DETAILED ACTION

1. This is a supplemental action in response to the telephone interview of 11/21/01. The shortened statutory period has been reset to start from the mailing of this office action.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 25-26, 33-35, 38 and 40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Stern et al.

As to claims 25, 33 and 38, Stern et al. disclose a cellular radio communication network operating over a predetermined frequency range subdivided in frequency into frequency bands, the network containing at least a first independent radio communication system 101 and a second independent radio communication system 102, each providing radio telecommunication service over a common geographical region (col. 2, lines 17-35), the technique comprising assigning from the predetermined frequency range at least one first frequency band to be used as a control channel by the first independent radio communication system (col. 4, lines 61-65), assigning from the predetermined frequency range at least one second frequency band to be used as a control channel by the second independent radio communication system (col. 4, lines 61-65), and sharing, or allocating on a shared basis, by the first independent radio communication and the second

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independent radio communication frequency bands in the portion of the predetermined frequency range not assigned as control channels to provide radio telecommunication service, or traffic channels, to a plurality of subscribers located in the common geographic area (col. 5, lines 4-27). It is considered that the sharing of the predetermined frequency range is in a "coordinated and synchronized" manner as recited in claims 26 and 40. Also disclosed is the allocation of frequency bands from the second frequency bands for traffic channels within a first one of the plurality of systems independently of the allocation of the second frequency bands within the second independent radio communication system since this band has been chosen in a preselected fashion as recited in claim 34. It is considered that the allocation of the second frequency bands to each of the systems of the network is dependent on the allocation of frequency bands to the other systems as recited in claim 35 in order to operate properly.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern et al.

As to claims 27-28, Stern et al. disclose everything claimed as explained above except for the above communication systems operating in a time division multiplexed manner. However, such a modulation technique is common and well known and therefore would have been obvious to one having ordinary skill in the art to use TDMA as the modulation for the above systems since one would want to select a modulation that best suits the needs of the system.

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***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 33-41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 33 and 38, the feature each of the plurality of radio communications systems being “exclusively” assigned a frequency band for use as control channels is not supported in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention. In fact, there is no description in the specification as to how the control channels are assigned and whether they are exclusively assigned to one of the systems. Given the fact that many collocated systems, during the time of the invention, often shared control channels with each other, it cannot be intrinsic to state that these frequency bands are exclusive of each other.

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***Reissue Applications***

9. Claims 42-46 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

Specific attention is given to new independent claims 42-46. During prosecution of the parent patent, applicant's added claim 23 in paper no. 8 (received May 22, 1995) contains the following features which were not recited in original claims 1 and 13, namely: "network monitoring means for monitoring the current network load of each of the plurality of wireless communication networks" and "generating a signal representing current operational characteristics of each of the wireless communications networks". These limitations are not found in reissue claims 42-46. Given the argument that claim 23 is "broader than the language describing networks contained in claims 1 and 13 as originally filed" as recited by applicant on page 7, lines 10-11, claim 23 is narrower in the above respects. Therefore, recapture applies to claims 42-46 which does not contain the above recited limitations.

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***Allowable Subject Matter***

10. Claims 29-32 are allowed.

11. Claims 36-37 and 41 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

12. Applicant's arguments with respect to claims 25-46 have been considered but are moot in view of the new ground(s) of rejection.



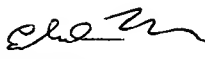
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*Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Urban whose telephone number is (703) 305-4385.

EFU

November 30, 2001

  
EDWARD F. URBAN  
PRIMARY EXAMINER